APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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ART UNIT	PAPER NUMBER
2151	20

DATE MAILED:
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Please find below and/or attached an Office communication concerning this application or pr ceeding.

Commissioner of Patents and Trademarks

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will
  be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this
  communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) _X_ Responsive to communication(s) filed on _12 April 2001_ .

2a) _X_ This action is **FINAL**.   2b) ___ This action is non-final.

3) ___ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) _X_ Claim(s) _34-51_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ___ Claim(s) _____ is/are allowed.

6) _X_ Claim(s) _34-51_ is/are rejected.

7) ___ Claim(s) _____ is/are objected to.

8) ___ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ___ The specification is objected to by the Examiner.

10) ___ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ___ The proposed drawing correction filed on _____ is: a) ___ approved b) ___ disapproved.

12) ___ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)_ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ___ All b) ___ Some * c) ___ None of the CERTIFIED copies of the priority documents have been:

        1. ___ received.

        2. ___ received in Application No. (Series Code / Serial Number) _____.

        3. ___ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ___ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ___ Notice of References Cited (PTO-892)
15) ___ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ___ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _.

17) ___ Interview Summary (PTO-413) Paper No(s). _____.
18) ___ Notice of Informal Patent Application (PTO-152)
19) ___ Other: .

DETAILED ACTION

This Office Action is responsive to Applicant's request for reconsideration, filed 12 April 2001.

1.   Request for copy of Applicant's response on floppy disk:
Please help expedite the prosecution of this application by including, along with your amendment response in paper form, an electronic file copy in WordPerfect, Microsoft Word, or in ASCII text format on a 3½ inch IBM format floppy disk. Please include all pending claims along with your responsive remarks. Only the paper copy will be entered -- your floppy disk file will be considered a duplicate copy. Signatures are not required on the disk copy. The floppy disk copy is not mandatory, however, it will help expedite the processing of your application. Your cooperation is appreciated.

2.   The U.S. Patents used in the art rejections below have been provided as text documents which correspond to the U.S. Patents. The relevant portions of the text documents are cited according to page and line numbers in the art rejections below. For the convenience of Applicant, the cited sections are highlighted in the *text documents*. Consistent with Office procedure, the U.S. Patents corresponding to the *text documents* are also included with this action.

3.   Claim Rejections - 35 U.S.C. § 103
        The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 34-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Admitted Prior Art – background of the instant Application (APA) in view of Lipe et al. (U.S. Patent 5,748,980).

As to claim 34, the APA p4 l8-17) teaches a method comprising:
providing an operating system package (OS) that includes a first configuration file (includes a configuration file) the first configuration file including information used by the operating system package to install first drivers (drivers) for a first

set of devices (devices ... associated with the computer) on a computer. The APA does not explicitly disclose the additional limitations detailed below. Lipe teaches providing a second configuration file external to the operating system package (configuration manager 158, p24 55 – p25 13) the second configuration file including information to direct the installation of a second driver for a second device (install devices 20, Id.) installing the second driver on the computer (drivers for the devices are loaded, p4 52 – p5 8) based on the information in the second configuration file (works in conjunction with the configuration manager to install devices, p24 55 – p25 13) and installing the operating system package on the computer (loading the operating system, p20 20-29) based on the information in the second configuration file (configuration process ... steps 66 and 68, Id.). It would have been obvious to combine Lipe's teachings with the APA because the configuration manager enables optimal automation in the set up of system hardware and software.

As to claim 35, the APA (background p3 l14 – p4 l2) teaches executing a setup program (software) of the operating system package (OS) to install the second driver (installs whatever drivers the device needs). It would have been obvious to combine the installation execution teachings with the APA as modified because the setup program that executes the appropriate OS configuration functions assist the user to complete the installation by simply running the setup program so that the device is fully operational.

As to claim 36, Lipe teaches "[t]he present invention enables a user of a computer to install a new device", p4 21-30 which corresponds to the second device is not included in the first set of devices. It would have been obvious to combine Lipe's new device installation teachings with the system of the APA as modified because a user may need to add a component on to the machine but the drivers for that new component are not present on the machine, so the second file provides a mechanism for adding new drivers to the system.

As to claim 37, Lipe teaches "customization of computer operations ... handling of application programs", p20 20-29, and from this, one skilled in the art would have provided for installing applications after the second driver and the operating system are installed. It would have been obvious to combine the customized handling of applications because the installation of application programs are dependent on the configuration of the system, and Lipe's setup routine enables efficient installation of a user's software package, including all of the programs that constitute the system applications.

As to claim 38, "Official Notice" is taken that determining one procedure from a plurality of options is well known in the art.   (MPEP 2144.03). In the interest of flexibility and efficiency, it would be important to incorporate a mechanism for choosing an installation procedure from a variety of possibilities, and it would have been obvious to combine this option determination principle with the APA as modified by Lipe, thereby furnishing the installation facility with a feature for determining one procedure for installation from a number of alternatives in order that the setup procedure suits the user's needs.

As to claims 39-40, Lipe (p18 12-26) teaches the second device (one of the devices 20) is identified dynamically (detected ... automatically). From this teaching, one skilled in the art would have provided the dynamic identification to be one of automated and user-driven. It would have been obvious to combine Lipe's teachings with the APA as modified because the automated and user-driven teaching provides enhanced installation capabilities, i.e. a user-friendly utility that powerfully manages the maintenance and upgrades for a system.

As to claim 41, "Official Notice" is taken that an ISA, PCI, SCSI, and an IDE device are component standards which are well known in the art. (MPEP 2144.03). It would have been obvious to combine components from the recited respective device standards with the APA/Lipe system because the adaptations for the variety of protocols enable automated management, maintenance, and installation for machines equipped with any of the recited device standard components.

As to claim 42, "Official Notice" is taken that a display device, a sound device, a modem, and a controller are components that need respective drivers for the system to function properly is well known in the art (MPEP 2144.03). It would have been obvious to combine the peripheral devices with the APA/Lipe system because the utilization of these common computing interfaces facilitates a user's ability to enjoy the maximum extent of the machines communication services.

As to claim 43, "Official Notice" is taken that the patching of errors in a first configuration file with information in a second configuration file is well known in the art (MPEP 2144.03). It would have been obvious to employ the file patching concept in the APA as modified by Lipe because the correcting of errors via patches from one file to a second file facilitates solution implementation/installation, thereby enabling a user to easily maintain the OS package, devices and machine in a properly performing status.

As to claims 44-50, note the rejections of claims 34, 37-39, and 41-43 respectively. Claims 44-50 are the same as claims 34, 37-39, and 41-43, except claims 44-50 are computer program product claims and claims 34, 37-39, and 41-43 are method claims.

As to claim 51, the APA teaches that the device drivers are typically installed during the OS installation, background p4 ln 15-17. Accordingly, the typical scenario would have setup the second device's driver contemporaneously with the OS installation. It would have been obvious to combine this packaging setup with the APA/Lipe system because the installation of the driver for the second (or any other) device during the OS setup would save time and eliminate the need for the user to perform the software configuration for the device.

5.   Response to Applicant's Arguments:

Applicant argues (claim 34) that Lipe's teaching combined with the APA does not meet the limitation of "a second configuration file external to the operating system". Contrary to Applicant's contention, the cited prior art does read-on the "second configuration file external to the OS package" as broadly claimed. Lipe's configuration manager is a VxD, p35 11-23, external to the operating system package/SYSTEM.INI file. The fact that a program or utility is bundled with the OS does not then make that software program/component intrinsic to the OS package. Lipe's config manager 158 is separate from the OS, and one skilled in the art would readily distinguish the config 158 module from the files/utilities that are an inextricable part of the OS. It is noted that the configuration module functions with the OS, but it is external to the OS. Thus, it should be recognized that Lipe is providing an overview in simplistic terms when he states that "the operating system 10 comprises numerous software programs or modules". This general reference in Lipe's teachings to the OS environment should not be misconstrued to mean that the programs/modules that operate in connection with the OS are therefore not external to the OS. Lipe's config module 158 is clearly distinct/external from the OS command interpreter package; indeed, Lipe's config manager 158 is a VxD that is separate from the OS kernel. In light of the foregoing, Lipe's teachings do read-on Applicant's limitation of the second config file is "external" to the OS.

The scope of the claimed configuration file "external to the operating system" clearly transcends the more narrow scope that Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

The recitations regarding the second configuration file are clearly subject to a broad interpretation, as detailed in the rejections maintained above. The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution (see *In re Prater, 56 CCPA 1381, 415F.2d 1393, 162 USPQ 541 (1969)*). Consequently, the APA as combined with the Lipe reference does meet the limitation of a second configuration file external to the OS package as claimed.

Applicant asserts (claim 44) "that the Examiner has not specifically pointed out a motivation or suggestion in the cited art for the proposed combination" of prior art references. In response, the Examiner notes that the test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section 103 if it 'would have been obvious ... to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992). The claim rejections supra show that Lipe's automated config utility would improve the APA's system of installing new hardware into a PC. Given the better system for "configuring a new device" as taught by Lipe, p10 28-30, and the needs/problems expressed in the APA, it would have been obvious to utilize Lipe's config manager module with the APA's OS and its configuration file. Hence, the combined system as presented herein would have dovetailed Lipe's teachings with the prior art to assist the user with the setup of new devices.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. For the reasons detailed above, the rejections set forth in the previous Office Action are maintained.

6.   THIS ACTION IS MADE FINAL.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL
ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS
ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO
MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE
ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE
THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE
SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE
ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO
37 C.F.R. □ 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF
THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD
FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF
THIS FINAL ACTION.

7.   Any inquiry concerning this communication or earlier communications
from the examiner should be directed to George Opie at (703) 308-9120 or
via e-mail at *George.Opie@uspto.gov*. Internet e-mail should not be used where
sensitive data will be exchanged or where there exists a possibility that sensitive
data could be identified unless there is an express waiver of the confidentiality
requirements under 35 U.S.C. 122 by the Applicant. Sensitive data includes
confidential information related to patent applications.

MAJID A. BANANKHAH
PRIMARY EXAMINER